

REMARKS

By this Amendment, Applicants amend claims 1, 8, 11, 13, and 18 and cancel claim 2. Accordingly, claims 1 and 3-18 are pending in this application, with claims 13-18 being withdrawn. Applicants also amend the specification and abstract for clarity. No new matter is added. Applicants respectfully request reconsideration of the pending claims at least in light of the following remarks.

The Office Action makes final the previously asserted Restriction Requirement and withdraws claims 13-18 from consideration. Applicants strenuously maintain their traversal of the requirement. In particular, the Restriction Requirement and Office Action have failed to suggest a materially different process that may be performed by the apparatus of claims 13-17 as required by MPEP §806.05(e).

Claim 13 recites a production apparatus for a recording apparatus comprising a recording layer device that "portions said continuous recording layer into a plurality of partitioned recording elements." Thus, the apparatus of Group II is not capable of forming a magnetic recording medium without a plurality of grooves to provide portioned recording elements as alleged by the Restriction Requirement. The Restriction Requirement's as well as the Office Action's arguments fail to give patentable weight to the explicit recording layer processing device feature of claim 13.

Because the Restriction Requirement has failed to suggest a materially different process that may be performed by the apparatus of claims 13-17 as required by MPEP §806.05(e), the Restriction Requirement is improper. Applicants respectfully request withdrawal of the Requirement and prompt and favorable consideration of pending claims 1-18.

Furthermore, the Office Action alleges that claim 18 is not generic. However, MPEP §809 (previously in §806.05(e), prior to the August 2005 revision of the MPEP) specifically

defines claim 18 as a linking claim that must be examined with the elected method claims.

Furthermore, Claim 18 does preclude other "materially different" methods, because claim 18 specifically requires means for performing each step of the method of claim 1. Accordingly, at least claim 18 must be rejoined and examined with elected claims 1 and 3-12.

The Office Action rejects claims 1, 2, and 8 under 35 U.S.C. §112, second paragraph as indefinite. By this Amendment, claims 1 and 8 are amended to remove the allegedly indefinite language, and claim 2 is canceled. Accordingly, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-2, 4, 7, and 9-12 under 35 U.S.C. §103(a) over Japanese Patent Publication JP A 09-097419 to Ichihara et al (hereinafter "Ichihara") in view of U.S. Patent Application Publication 2005/0167770 A1 to Fukuzawa et al. (hereinafter "Fukuzawa"). Applicants respectfully traverse the rejection.

Neither Ichihara nor Fukuzawa disclose, teach, or suggest that "said recording layer processing step, said non-magnetic body filling step, and said protective layer formation step are conducted with an environment surrounding said intermediate product maintained in a state of vacuum all through these steps," as recited in claim 1. In particular, as the Office Action correctly recognizes, Ichihara fails to disclose, teach, or suggest, such a feature (Office Action, page 4). However, Fukuzawa fails to make up for this deficiency of Ichihara.

Fukuzawa only discloses performing a deposition step and a heat treatment step with the environment surrounding the intermediate product in a state of vacuum. Importantly, Fukuzawa does not disclose maintaining the environment surrounding the intermediate product in a state of vacuum through a plurality of steps including a step for etching the intermediate product. Thus, Fukuzawa cannot be relied on as disclosing teaching or suggesting "said recording layer processing step, said non-magnetic body filling step, and said protective layer formation step are conducted with an environment surrounding said

intermediate product maintained in a state of vacuum all through these steps," as recited in claim 1.

Thus, both Ichihara and Fukuzawa, either alone or in combination, fail to disclose all of the features of claim 1. Accordingly, claim 1 is patentable over the combination of Ichihara and Fukuzawa. Further, claims 4, 7, and 9-12 are patentable for at least the reason that claim 1 is patentable, as well as for the additional features they recite. Applicants thus respectfully request withdrawal of the rejection.

Furthermore, even if Fukuzawa did disclose, teach, or suggest "said recording layer processing step, said non-magnetic body filling step, and said protective layer formation step are conducted with an environment surrounding said intermediate product maintained in a state of vacuum all through these steps," (which Applicants traverse above), the Office Action has failed to provide a motivation for modifying Ichihara to include such a feature.

The Office Action alleges that it would have been obvious to perform "steps" of Ichihara in a vacuum "because Fukuzawa et al [sic] teaches need [sic] for high capacity media." However, Fukuzawa does not disclose or even suggest that it is the vacuum that results in high-capacity media. Thus, the skilled artisan would not be motivated to perform any steps of the method of Ichihara in a vacuum to obtain high-capacity media. Thus, the Office Action has failed to provide a motivation for combining Ichihara and Fukuzawa as necessary for a *prima facie* case of obviousness (see MPEP §§ 2142, 2143). As a result, the rejection is improper. For this additional reason, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claim 3 under 35 U.S.C. §103(a) over Ichihara and Fukuzawa in view of U.S. Patent Application Publication 2001/0020516 to Khan et al. (hereinafter "Khan"); claims 5-6 under 35 U.S.C. §103(a) over Ichihara and Fukuzawa in view of U.S. Patent Application Publication 2005/0147793 to Kruger et al. (hereinafter

"Kruger"); and claim 8 under 35 U.S.C. §103(a) over Ichihara and Fukuzawa in view of Japanese Patent Publication JP A 11-130329 to Mashita et al. (hereinafter "Mashita").

Applicants respectfully traverse the rejections.

These rejections are premised upon the presumption that the combination of Ichihara and Fukuzawa discloses, teaches, or suggests all of the features of claim 1. Because, as discussed above, the combination of Ichihara and Fukuzawa does not disclose, teach, or suggest all of the features of claim 1, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1 and 3-18.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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JAO:JOC/smo

Attachment:

Amended Abstract
Petition for Extension of Time w/ Check # 178608 (\$120)

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